REMARKS

The Office Action dated August 27, 2004 has been fully considered by the Applicant. In connection therewith, the Applicant has amended Claim 2 to address the claim objections identified by the Examiner. The limitations of Claim 4 have been incorporated into independent Claim 1.

The rejection of Claims 1 through 3, as now amended, under 35 U.S.C. §103(a) as unpatentable over Lucas (U.S. Patent No. 6,170,145) in view of Koller (U.S. Patent No. 4,126,936) and Bihler (U.S. Patent No. 2,914,166) is respectfully traversed.

While the swaging step to produce a swage termination is known and shown in Lucas, the present invention is otherwise dissimilar. Koller illustrates crimping and embossing an end on an electrical wire but is otherwise dissimilar. As now clearly conveyed, the steps in the present invention must be accomplished in the order set forth in the claims. The Examiner's approach of utilizing the placement or positioning of the Bihler opaque tag over a sleeve can only occur in the present invention after application of adhesive to a surface of the sleeve. This step in Claim 1, lines 5-6 is not only not shown in the prior art, and the Office Action does not even attempt to show the accomplishment of this step.

Finally, as now amended, Claim 1 clarifies that the step of encasing the tag with a transparent material by injection molding is an independent step following adhesively securing the tag to the sleeve. As shown on the inventor's sketch submitted herewith, the injection molding step is not disclosed or suggested in any prior art reference.

In contrast, the teaching of Bihler is a tape incorporating an adhesive therein which has both an opaque and a transparent portion so that the Bihler tape is simply wound around a pipe.

Accordingly, the combination of Lucas, Koller and Bihler, taken together as suggested by the Examiner, does not achieve the limitations and elements of Claim 1.

Additionally, Bihler is directed to non-analogous art. As set forth throughout Bihler, it is directed to "labels of the type which may be adhesively and removably attached to articles". Removability of the identifying information in the present invention renders the wire rope assembly worthless.

Moreover, it is inappropriate and improper to combine three disparate references. While Lucas shows one example of a process for swaging a termination on a wire rope, it is otherwise dissimilar. The Bihler reference pertains to placing a tape around "articles such as electric leads, tubings, or the like. . ." (column 1, lines 18-19).

Claims 2 and 3 are dependent on Claim 1 and believed allowable for all of the same reasons.

The rejection of Claim 5, as now amended, under 35 U.S.C. §103(a) as unpatentable over Lucas in view of Koller and Bihler is respectfully traversed. While Lucas shows a wire rope with a swage termination, it is otherwise dissimilar.

The Koller reference simply shows crimping of a terminal lug with alphanumeric characters embossed onto the electrical wire. Applicant admits that it is known to provide identification on wire ropes. Koller does not pertain to a wire rope nor does it apply a separate tag, independent of the swage termination itself.

In summary, the combination of Koller, Bihler and Lucas, taken together, do not achieve the elements of the present invention. Accordingly, the Section 103 rejection is not well taken.

Moreover, the combination of three disparate references in improper. It is improper to combine references to achieve the invention under consideration unless there is some incentive or suggestion in the references to do so.

The Court of Appeals for the Federal Circuit has repeatedly held that under Section 103, teachings from various references can be combined only if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F2d 1572, 221 USPQ 929 (CAFC 1984).

> Stated another way:
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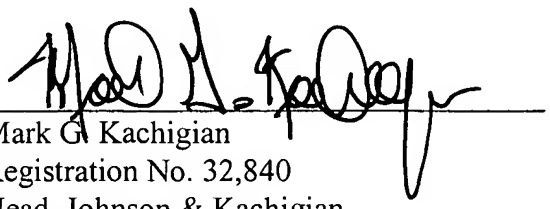
> It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps...The references themselves must provide some teaching whereby the applicant's combination would have been obvious. In re Gorman, 18 USPQ2d 1885 (CAFC 1991).

The Examiner is required to follow the law as set forth by the Federal Circuit. In summary, the combination of patents to achieve the claims of the present invention is untenable.

Also enclosed is a check in the amount of $60 for the Request for a One-Month Extension of Time.

It is believed the application is now in condition for allowance and such action is earnestly solicited.

Respectfully submitted,



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